

REMARKS

Claims 19-38 are pending in the instant application. Claims 20-22, 25, 28, 30-32, and 37 have been canceled without prejudice. Claims 1-18 stand canceled. Claim 19 has been amended to more clearly delineate the invention. Claims 19, 23, 24, 26, 27, 29, 33-36, and 38 will be pending upon entry of the within amendment. No new matter has been added.

Claim Rejection – 35 U.S.C. §112, first paragraph

Claims 19-38 are rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement. Applicants disagree and respectfully traverse in view of the claim amendments herein. Claim 19 has been amended to include specific embodiments for the definitions of A, Y, R¹, R², R³, R⁴, R⁵, R⁷, and R⁸. Additionally, the claims have been amended to delete prodrugs. The rejection is overcome and withdrawal of the rejection is respectfully requested.

Claim Rejection – 35 U.S.C. §102

Claims 19-38 are rejected under 35 U.S.C. §102(e) as anticipated by Hubschwerlen et al. (WO 2004/096221). The Office Action alleges that Hubschwerlen provides for the compounds of the present invention and has an earlier priority date.

Applicants disagree and respectfully traverse.

The claims as currently amended include a six-membered piperidine ring that includes a 4-position definition of “Q is CR₄.” The definition of R₄ as currently amended includes hydroxy, a group of formula OPO₃R⁹₂, OSO₃R¹⁰, OCH₂OPO₃H₂, OCOCH₂CH₂COOH or an ester of a naturally occurring amino acid or a derivative thereof. Thus, the Applicants claims are directed towards a compounds having a piperidine core structure that is substituted at the 4-position with an oxygen-containing group.

Hubschwerlen (WO 2004/096221) claims priority to two US provisional applications: USSN 60/466,945 (filed on April 30, 2003) and USSN 60/530,822 (filed December 18, 2003). The instant application also claims priority to USSN 60/530,822 (filed December 18, 2003). USSN

60/530,822 is therefore not prior art. A copy of the prior art document (USSN 60/466,945) is provided herein as Exhibit A.

Applicants submit that the disclosure of USSN 60/466,945 does not provide for the compounds of the Applicants' claims. Specifically, USSN 60/466,945 does not provide for a compound comprising a piperidine ring that is substituted at the 4-position with an oxygen-containing group. Page 2 of USSN 60/466,945 provides for a structural representation wherein "A" provides for a heterocycloalkylen group, as well as an ether linker. Elaboration of the heterocycloalkylen group can be found at least at pages 8-13 of USSN 60/466,945, wherein such a ring may be substituted F atoms.

Thus, USSN 60/466,945, the only document having a priority date earlier than the Applicants' priority date, does not provide for the compounds of the Applicants' claims. The rejection is overcome and withdrawal of the rejection is respectfully requested.

Claim Rejection – 35 U.S.C. §103

Claims 19-38 are rejected under 35 U.S.C. §103(a) as obvious over USSN 10/491,519 (US 2005/0096343) in view of Hubschwerlen et al. (WO 2004/096221). The Office Action alleges that USSN 10/491,519 provides the compounds of the instant invention which lack the "R₄" group definitions. The Office Action further alleges that Hubschwerlen provides for the lacking definition of the R₄ group.

As discussed supra, Hubschwerlen et al., or more specifically the priority application, does not teach or suggest that the pyridine ring can be substituted by an oxygen-containing group. Additionally, the Office Action has already stated that USSN 10/491,519 does not have the R₄ group of the invention. Therefore, neither of USSN 10/491,519 or Hubschwerlen, whether alone or in combination, teaches or suggests the compounds of the Applicants' claimed invention.

The rejection is overcome and withdrawal of the rejection is respectfully requested.

Double Patenting Rejections

Applicants' claims are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over USSN 12/455,810 and USSN 10/491,519. Applicants disagree and respectfully traverse and will address the rejections upon the allowance of patentable subject matter.

In view of the above remarks, Applicants believe the pending application is in condition for allowance. Should any of the claims not be found to be allowable, the Examiner is requested to telephone Applicants' undersigned representative at the number below. Applicants thank the Examiner in advance for this courtesy.

The Director is hereby authorized to charge any credits or deficiency in the fees filed (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 65507 (41925).

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Respectfully submitted,

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